

REMARKS

At the time of the Office Action dated December 18, 2003, claims 1-21 were pending. In this Office Action, the Examiner rejected all the pending claims and objected to the specification, drawings and claims.

In this Amendment, claims 1-21 have been canceled, and new claims 26-47 have been added. New claims 26-45 correspond to canceled claims 1-16 and 18-21, respectively. New claim 47 has been prepared based on claim 11, i.e., new claim 47 recites a limitations originally recited in claim 11. Adequate descriptive support for new claim 46 can be found on, for example, page 38, lines 6-15 of the specification. Care has been exercised to avoid the introduction of new matter.

Oath/Declaration.

The Examiner pointed out that the signature of Inventor 202 was altered. In response, a corrected Declaration for Mr. Hiroshi Ono and Mr. Kazunori Ito is attached to this Amendment.

Specification.

The Examiner has requested to review the specification for minor errors. Based on Applicants' cursory review, the specification has been amended (see the Substituted Specification).

Drawings.

The drawings have been objected to because of informalities. In response, Applicants have amended the drawings, as attached, to obviate the stated bases for the objection to the drawings.

Applicants note that the line from 3 and the solid portion of a core 3 does not show underlying structure in Fig. 1 because a liquid impervious sheet 1 and a top tissue paper 3A are removed in part so that an absorbent core 3 can be seen. Accordingly, the line from the core 3 and the solid portion of the core 3 do not need to be dashed.

The Examiner also objected to the drawings because they do not show the invention as claimed in claim 5, now, new claim 30. In response, Applicants submit that every feature of the invention in claim 5 are shown in, for example, Figs. 1, 2A and 2B, and also supported on, for example, page 20, lines 3-12 of the specification.

Applicants, therefore, respectfully solicit withdrawal of the objections to the drawings.

Description.

The description has been objected to because of informalities. In response, Applicants have amended the description of the specification to obviate the stated bases for the specification objections (see the Substituted Specification).

In paragraph 4 of the Office Action, the Examiner, noting the second figure of Figure 2 (now, Fig. 2B), questioned what the phantom lines are showing. In response, the phantom lines show a position which a surface contacting portion 20 reaches when standing force is applied to the surface contacting portion 20 by stretching members 5 (see paragraph 103 of the Substitute Specification).

Accordingly, withdrawal of the objections to the description is respectfully solicited.

Claim Objections.

The Examiner also objected to the claims. In response, Applicants have replaced all the pending claims with new claims in consideration of the Examiner's comments. Applicants, therefore, respectfully solicit withdrawal of the objection to the claims.

Claims 1-5 and 7-20 have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

In response to the Examiner's 112, second paragraph rejection, Applicants prepared new claims 26-30 and 32-44 for replacing claims 1-5 and 7-20 to eliminate issues pointed out by the Examiner.

It is noted that in the statement of the rejection, the Examiner raised a question: "In regard to claim 18, are the width and length on lines 3 and 5 and the width and length of the article one and the same?" (the ultimate sentence in paragraph 8 of the Office Action). In response, Applicants submit that the Examiner's question is irrelevant to this rejection because the width and length in claim 18 indicate a unit to measure stretching stress of those portions.

Accordingly, Applicants respectfully solicit withdrawal of the rejection of claims 1-5 and 7-20 and favorable consideration of new claims 26-30 and 32-44.

Claims 1-4 and 6 have been rejected under 35 U.S.C. §102(b) as being anticipated by Roe et al.

In the statement of the rejection, the Examiner asserted that Roe et al. discloses an absorbent article having integral barrier cuffs identically corresponding to what is claimed. This rejection is respectfully traversed.

It is noted that claim 1-4 and 6 correspond to new claims 26-29 and 31, respectively.

The factual determination of lack of novelty under 35 U.S.C. §102 requires the identical disclosure in a single reference of each element of the claimed invention, such that the identically claimed invention is placed into the possession of one having ordinary skill in the art. *Helifix Ltd. v. Blok-Lok, Ltd.*, 208 F. 3d 1339, 54 USPQ2d 1299 (Fed. Cir. 2000); *Electro Medical Systems S.A. v. Cooper Life Sciences, Inc.*, 34 F.3d 1048, 32 USPQ2d 1017 (Fed. Cir. 1994).

Based on the above legal tenet, Applicants submit that Roe et al. does not disclose a disposable absorbent article including all the limitations recited in independent claims 26, 27 and 31 within the meaning of 35 U.S.C. §102. Specifically, Roe et al. does not disclose a free portion and stretching members provided on the free portion of the claimed invention. In the claimed invention, the free portion comprises a standing portion, a folding portion and a contacting portion, and each of the standing portion and contacting portion has at least one of the stretching members.

On the other hand, Roe et al. appears to have a cuff area 102 having three portions similar to that of the claimed invention (see Fig. 3; column 10, lines 51-67; and column 13, line 57 to column 14, line 4). However, Roe et al. does not disclose where stretching members are provided in the cuff area 102 in Fig. 3. Roe et al. merely shows that a spacing means (elastic member) is provided only at a distal edge of the cuff area 102 (see Fig. 3). Figs. 1, 4, 7 and 9 of Roe et al. also disclose two or more elastic members provided in a cuff area, although the structure of the cuff area is different from that of the claimed invention.

Accordingly, Applicants submit that Roe et al. does not disclose all the limitations recited in independent claims 26, 27 and 31, and therefore, does not have identical disclosure of each element of the claimed invention in the meaning of 35 U.S.C. §102.

It is further noted that a dependent claim is not anticipated if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claim. Therefore, claims 28 and 29 are patentable because they respectively include all the limitations of independent claim 26. The Examiner's additional comments with respect to those claims do not cure the argued fundamental deficiencies of Roe et al.

Therefore, Applicants respectfully solicit withdrawal of the rejection of claims 1-4 and 6 and favorable consideration of new claims 26-29 and 31.

Claim 5 has been rejected under 35 U.S.C. §102(b) as being anticipated by Bruemmer et al. New claim 30 corresponds to claim 5.

In the Statement of the rejection, the Examiner asserted that Figs. 10, 11, 12 and 13 of Bruemmer et al. disclose what is claimed.

In response, Applicants submit that reference does not disclose all the limitations recited in original claim 5 within the meaning of 35 U.S.C. §102. *Helifix Ltd.*, 208 F. 3d 1339; *Electro Medical Systems S.A.*, 34 F.3d 1048.

As to an absorbent article disclosed in Figs. 10 and 11 of Bruemmer et al., the reference does not disclose the limitation "said stretching members are provided on said contact portion and said standing portion, respectively," recited in new claim 30. The article shown in Figs. 10 and 11 has flap elastics 40 provided only to a distal edge of a containment flap. Relevant

description does not mention that flap elastics 40 can be provided to another location (see column 8, line 53 to column 9, line 11).

An absorbent article shown in Figs. 12 and 13 does not have a free portion as recited in new claim 30, either. The claimed invention has a free portion comprising a standing portion “extending from the base line toward a longitudinal centerline of said article, the free portion, other than the standing portion, folding laterally outward away from the longitudinal centerline at a predetermined folding portion to define a contacting portion.” On the other hand, a containment flap shown in Figs. 12 and 13 of the reference has a portion extending outward and then folding backward. Therefore, the free portion of the claimed invention is different from the containment flap of Bruemmer et al. in structure.

Accordingly, Applicants submit that Bruemmer et al. does not disclose all the limitations recited in claim 30, and therefore, does not have identical disclosure of each element of the claimed invention in the meaning of 35 U.S.C. §102. Therefore, Applicants respectfully solicit withdrawal of the rejection of claim 5 and favorable consideration of new claim 30.

Claims 7-9 and 21 have been rejected under 35 U.S.C. §102(e) as being anticipated by St. Louis et al.

New claims 32-34 and 45 correspond to claims 7-9 and 21. Applicants note that new claim 32, corresponding to claim 7, includes limitations originally recited in claim 8.

In the statement of the rejection, the Examiner asserted that St. Louis et al. discloses an absorbent article identically corresponding to what is claimed.

In response, Applicants submit that St. Louis et al. does not disclose a disposable absorbent article including all the limitations recited in independent claim 32. Specifically,

Applicants submit that a leg gusset section 142 of St. Louis et al. does not correspond to the free portion of the claimed invention because the section 142 of the reference extends in a direction different from that of the free portion of the claimed invention.

On the other hand, St. Louis et al. discloses a containment flap section 144 extending toward a longitudinal centerline of an absorbent article 10 (see Figs. 1 and 2). However, the reference does not disclose that the containment flap section 144 includes stretching members having an effective stretching length different from each other.

In the statement of the rejection for claim 8, the Examiner further asserted that that top and lower right hand sides of 142 (leg gusset section), i.e. two outermost or distal edge strands 138, are not overlaid by a pocket 80 while two innermost or base line-side strands are overlaid by a pocket (see Fig. 1), in order to show that an effective stretching length of the “top and lower right hand sides of 142” is different from that of the “two innermost or base line-side strands.” However, as discussed above, since the “top and lower right hand sides of 142” are part of the leg gusset section 142, it is not necessary to consider the “top and lower right hand sides of 142.” The leg gusset section 142 does not correspond to the free portion of the claimed invention. In addition, the Examiner’s cited portions do not disclose that each containment flap section 114 has stretching member each having an effective stretching length different from another (column 10, lines 38-39; column 26, lines 13-37; and column 27, lines 11-55).

Accordingly, Applicants submit that St. Louis et al. does not disclose all the limitations recited in new claim 32, and therefore, does not have identical disclosure of each element of the claimed invention in the meaning of 35 U.S.C. §102. See *Helifix Ltd.*, 208 F. 3d 1339; *Electro Medical Systems S.A.*, 34 F.3d 1048.

It is also noted that new claims 33 and 34, corresponding to claims 8 and 9, respectively, are patentable because they respectively include all the limitations of independent claim 32. The Examiner's additional comments with respect to claims 8 and 9 (new claims 33 and 34) do not cure the argued fundamental deficiencies of St. Louis et al.

Further, Applicants submit that that St. Louis et al. does not disclose all the limitations recited in claim 21, now new claim 45. The Examiner may say that a waist pocket member 80 shown in Figs. 1-3 of the reference corresponds to a standing cuff in claim 45. However, the waist pocket member 80 does not have "a two-layer sheet and a water proof sheet disposed between layers of the two-layer sheet," as recited in claim 45. In fact, St. Louis et al. discloses that "The pocket section also includes a substantially liquid impermeable pocket barrier layer 106, and a pocket fabric layer 108 which is connected in facing relation with the pocket barrier layer" (column 12, lines 44-48).

Accordingly, Applicants submit that St. Louis et al. does not disclose all the limitations recited in new claim 45, and therefore, does not have identical disclosure of each element of the claimed invention in the meaning of 35 U.S.C. §102. *See Helifix Ltd.*, 208 F. 3d 1339; *Electro Medical Systems S.A.*, 34 F.3d 1048. Applicants note that new claim 46 is also patentable because it includes all the limitations recited in claim 45.

Therefore, Applicants respectfully solicit withdrawal of the rejection of claims 7-9 and 21, and favorable consideration of new claims 32-34 and 45.

Claims 14-17, 19 and 20 have been rejected under 35 U.S.C. §102(b) as being anticipated by Laux et al.

In the statement of the rejection, the Examiner asserted that Laux et al. discloses an absorbent article identically corresponding to what is claimed.

It is noted that new claims 39-41, 43 and 44 correspond to claims 14-16, 19 and 20. In this Amendment, claim 39 has been prepared to include the limitation recited in original claim 17. Original claim 17 recites the relationship between the stretching members and their contraction force.

By citing two portions from Laux et al., the Examiner asserted that the reference discloses the limitation recited in original claim 17. However, Applicants submit that one of the portions is completely irrelevant to the claimed invention (see page 20, lines 17-23). The reference merely describes a waistband “notch” region 96, which does not correspond to a stretching member of the claimed invention. Another portion merely states that “The number of elastic strands and the spacing between the strands can be selected and arranged to provide desired performance” (see page 23, lines 14-17). This portion does not explain what is claimed in new claim 39, either.

Accordingly, Applicants submit that Laux et al. does not disclose all the limitations recited in new claim 39 including the limitation “said stretching member extending between the base line and the longitudinal centerline of said free portion has contraction force stronger than that of said stretching member extending along the distal edge of said free portion.” Therefore, Laux et al. does not have identical disclosure of each element of the claimed invention in the meaning of 35 U.S.C. §102. *See Helifix Ltd.*, 208 F. 3d 1339; *Electro Medical Systems S.A.*, 34 F.3d 1048. Applicants further submit that dependent claims 40, 41, 43 and 44 are also patentable because they respectively depend on independent claim 39.

Therefore, Applicants respectfully solicit withdrawal the rejection of claims 14-17, 19 and 20, and favorable consideration of new claims 39-41, 43 and 44.

Claim 10 has been rejected under 35 U.S.C. §102(e) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over St. Louis et al.

In response to the rejection, Applicants submit that original claim 10, now claim 35, is dependent on new claim 32 which is patentable for the reasons set forth above. Accordingly, Applicants respectfully solicit withdrawal of the rejection of claim 10 and favorable consideration of new claim 35.

Claims 11-13 have been rejected under 35 U.S.C. §103(a) as being unpatentable over St. Louis et al. in view of Minetola et al.

Applicants note that new claim 36, corresponding to original claim 11, is prepared by referring to page 32, line 27 to page 33, line 23; and page 34, line 22 to page 35, line 9 of the specification.

In the statement of the rejection, the Examiner asserted that it would have been obvious to make the tissue of St. Louis creped as taught by Minetola et al. to arrive at the claimed invention.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Applicants submit that the proposed combination of St. Louis and Minetola et al. does not suggest a disposable absorbent article including all the limitations recited in new claim 36. Specifically, the proposed combination of St. Louis et al. and Minetola et al. does not disclose

“second stretching member for deforming said longitudinal end of said absorbent structure, said second stretching members provided between the base line of said at least one standing cuff and the longitudinal centerline of said article.” The second stretching member corresponds to absorbent structure’s opposite sides stretching member recited in original claim 11. Applicants’ review of the references revealed that they are silent on the second stretching member.

With respect to original claims 12 and 13, now new claims 37 and 38, Applicants submit that claims 37 and 38 are patentable because they depend on claim 26 which is patentable for the reasons set forth above. Since the proposed combination does not disclose all the limitations recited in claim 26, the proposed combination does not teach or suggest all the limitations recited in new claims 37 and 38. *See In re Royka*, 490 F.2d 981.

Accordingly, the proposed combination of St. Louis et al. and Minetola et al. does not teach or suggest a disposable absorbent article including all the limitations recited in claims 36-38. Applicants, therefore, solicit withdrawal of the rejection of claims 11-13 and favorable consideration of new claims 36-38. Applicants further submit that new claim 47 depending on claim 36 is also patentable because if an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

Claim 18 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Laux et al.

In response, Applicants submit that as claim 39 is patentable for the reasons set forth above, it is submitted that claim 18, now new claim 42, which depends from claim 39 is also patentable. The Examiner’s additional comments with respect to the claim do not cure the

argued fundamental deficiencies of Laux et al. Therefore, Applicants respectfully solicit withdrawal of the rejection of claim 18 and favorable consideration of new claim 42.

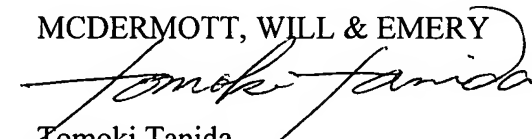
Conclusion.

Accordingly, it is urged that the application is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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